



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,667	04/22/2004	Arnold Thaler	074104.0121	6830
23640 7590 06/02/2008 BAKER BOTTS, LLP 910 LOUISIANA HOUSTON, TX 77002-4995				
EXAMINER KAMAL, SHAHID				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 06/02/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

debbie.allen@bakerbotts.com

### Office Action Summary

**Application No.**

10/829,667

**Applicant(s)**

THALER, ARNOLD

**Examiner**

SHAHID KAMAL

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

***Acknowledgements***

1. In light of applicant's arguments and because the species are not patentability distinct, the Election of Species mailed on February 06, 2008 is hereby withdrawn.
2. Claims 1-52 are currently pending.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 9,12, 14-15, 19-20, 41-46, 50, and 52 are rejected under 35 U.S.C. 102(e) as anticipated by Appalucci et al. (US Pub. No. 2003/0057276 A1) ("Appalucci").

Referring to claim 1, Appalucci discloses the following:

a) a product (item) having control circuits (barcode) (Paragraph 0004 –standard barcode label of the type which may be used for identifying an item during a manufacturing process); and

b) a verification and activation module (RFD tags) coupled to the control circuits (barcode) of the product (item), wherein the verification and activation module activates the control circuits (barcode) of the product (item) (Paragraph 0004 –standard barcode label of the type which may be used for identifying an item either during a manufacturing process, during storage or shipment, at the time of checkout from a retailer or other facility).

Referring to claim 2, Appalucci discloses wherein the verification and activation module (RFD tags) is removably coupled to the product (item) (Paragraph 0004 –RFD tags are removable).

Referring to claim 3, Appalucci discloses wherein the control circuits of the product are deactivated when the verification and activation module is not coupled to the product (Paragraph 0021).

Referring to claim 4, Appalucci discloses wherein the verification and activation module is programmed with information (Paragraphs 0005, 0020).

Referring to claim 5, Appalucci discloses wherein the programmed information comprises purchase date and price of the product (Paragraph 0032).

Referring to claim 6, Appalucci discloses wherein the programmed information comprises warranty information for the product (Paragraph 0032).

Referring to claim 7, Appalucci discloses wherein the programmed information comprises data about a consumer who purchased the product (Paragraph 0024).

Referring to claim 9, Appalucci discloses wherein the programmed information comprises data about the product (Paragraph 0004).

Referring to claim 12, Appalucci discloses wherein the product comprises verification and activation circuits (Paragraph 0004).

Referring to claim 14, Appalucci discloses a security feature that deactivates the product when outside of a geographical location (Paragraph 0019).

Referring to claim 15, Appalucci discloses a security feature that deactivates the product when a security signal is not present (Paragraph 0021).

Referring to claim 19, Appalucci discloses a communications interface coupled to the verification and activation module (Paragraph 0004).

Referring to claim 20, Appalucci discloses wherein the communications interface is selected from the group consisting of WIFI and Bluetooth (Paragraph 0004).

Referring to claim 41, Appalucci discloses wherein the communication is wireless (Paragraph 0004).

Referring to claim 42, Appalucci discloses wherein the communication is by wire (Paragraph 0004).

Referring to claim 43, Appalucci discloses the following:

- a) reading product information from a universal product code (UPC) label (Paragraph 0005);
- b) entering consumer information (Paragraph 0004);
- c) programming the product information and the consumer information into an activation module (Paragraph 0004); and
- d) activating the product (item) with the activation module (Paragraph 0004).

Referring to claim 44, Appalucci discloses the step of programming store information into the activation module (Paragraph 0004).

Art Unit: 3621

Referring to claim 45, Appalucci discloses the step of programming warranty information into the activation module (Paragraph 0032).

Referring to claim 46, Appalucci discloses the step of programming purchase date and price of the product into the activation module (Paragraph 0032).

Referring to claim 50, Appalucci discloses providing a product having a verification and activation module (Paragraph 0004); and communicating with the verification and activation module such that the product is enabled for operation when a correct security code is communicated to the verification and activation module (Paragraph 0004).

Referring to claim 52, Appalucci discloses wherein the product service information is selected from the group consisting of warranty repair and replacement of the product (Paragraph 0003).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

6. Claims 8, 10-11, 13, 16-18, 21-40, 47-49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appalucci et al. (US Pub. No. 2003/0057276 A1) ("Appalucci") in view of Forth et al. (US Pub. No.: 2004/0205343 A1) ("Forth").

Referring to claim 8, Appalucci does not expressly disclose wherein the programmed information comprises data about a manufacturer of the product.

Forth discloses wherein the programmed information comprises data about a manufacturer of the product (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 10, Appalucci does not expressly disclose wherein the verification and activation module comprises a non-volatile programmable memory.

Forth discloses wherein the verification and activation module comprises a non-volatile programmable memory (Paragraphs 0033, 0040).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 11, Appalucci does not expressly disclose wherein the non-volatile memory is selected from the group consisting of electrically erasable and programmable read only memory (EEPROM), Flash memory and battery backed-up random access memory (RAM).

Forth discloses wherein the non-volatile memory is selected from the group consisting of electrically erasable and programmable read only memory (EEPROM), Flash memory and battery backed-up random access memory (RAM) (Paragraph 0065).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 13, Appalucci does not expressly disclose wherein the verification and activation module comprises a non-volatile programmable memory, and verification and activation circuits.

Forth discloses wherein the verification and activation module comprises a non-volatile programmable memory, and verification and activation circuits (Paragraphs 0033, 0040).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s)

taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 16, Appalucci does not expressly disclose wherein warranty history of the product is stored in the non-volatile memory.

Forth discloses wherein warranty history of the product is stored in the non-volatile memory (Paragraphs 0033, 0040).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 17, Appalucci does not expressly disclose wherein repair history of the product is stored in the non-volatile memory.

Forth discloses wherein repair history of the product is stored in the non-volatile memory (Paragraphs 0033, 0040).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 18, Appalucci does not expressly disclose wherein maintenance history of the product is stored in the non-volatile memory.

Forth discloses wherein maintenance history of the product is stored in the non-volatile memory (Paragraphs 0033, 0040).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 21, Appalucci discloses a product (item) (Paragraph 0004); a verification and activation module (Paragraph 0004); and a module programmer for programming the verification and activation module, the module programmer is coupled to the point of sale terminal, wherein information from the point of sale terminal is programmed into the verification and activation module so that the product is activated when coupled to the verification and activation module (Paragraph 0004).

Appalucci does not expressly disclose a point of sale terminal.

Forth discloses a point of sale terminal (Paragraph 0050).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 22, Appalucci discloses a package, wherein the product is in the package (Paragraph 0004).

Referring to claim 23, Appalucci discloses wherein the verification and activation module is in the package (Paragraph 0004).

Referring to claim 24, Appalucci discloses a universal product code(UPC) label on the package (Paragraph 0005).

Referring to claim 25, Appalucci discloses a UPC reader coupled to the point of sale terminal, wherein part of the information programmed into the verification and activation module is from the UPC label (Paragraph 0005).

Referring to claim 26, Appalucci discloses a credit card reader that is adapted to read a credit card, the credit card reader is coupled to the point of sale terminal, wherein some of the information programmed into the verification and activation module is from the credit card (Paragraph 0004).

Referring to claim 27, Appalucci discloses wherein the programmed information comprises purchase date and price of the product (Paragraph 0032).

Referring to claim 28, Appalucci discloses wherein the programmed information comprises warranty information for the product (Paragraph 0032).

Referring to claim 29, Appalucci discloses wherein the programmed information comprises data about a consumer who purchased the product (Paragraph 0024).

Referring to claim 30, Appalucci does not expressly disclose wherein the programmed information comprises data about a manufacturer of the product.

Forth discloses wherein the programmed information comprises data about a manufacturer of the product (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 31, Appalucci discloses wherein the verification and activation module includes an RFID device and the module programmer comprises an RFID programmer (Paragraph 0004).

Referring to claim 32, Appalucci discloses wherein the RFID programmer further comprises an RFID reader for reading information stored in the RFID device (Paragraph 0004).

Referring to claim 33, Appalucci discloses a package (Paragraph 0004); a product in the package (Paragraph 0004); a verification and activation module in the package (Paragraph 0004); a universal product code (UPC) label on the package (Paragraph 0005); a UPC reader (Paragraph 0005); and a module programmer for programming the verification and activation module, the module programmer is coupled to the point of sale terminal, wherein information from the UPC reader and the point of sale terminal are programmed into the verification and activation module (Paragraph 0005).

Appalucci does not expressly disclose a point of sale terminal coupled to the UPC reader.

Forth discloses a point of sale terminal coupled to the UPC reader (Paragraph 0050).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 34, Appalucci discloses wherein the information from the UPC reader and the point of sale terminal are programmed into the verification and activation module by wireless transmission (Paragraph 0005).

Referring to claim 35, Appalucci discloses wherein the wireless transmission is by radio frequency signals (Paragraph 0004).

Referring to claim 36, Appalucci discloses wherein the wireless transmission is by infrared signals (Paragraph 0004).

Referring to claim 37, Appalucci discloses wherein the wireless transmission is by electromagnetic signals (Paragraph 0004).

Referring to claim 38, Appalucci disclose an original product (item) (Paragraph 0004); a verification and activation module (RFD tags) coupled to the original product (item) (Paragraph 0004).

Appalucci does not expressly disclose a replacement product, wherein when the verification and activation module (RFD tags) is removed from the original product and coupled to the replacement product, the replacement product is enabled for operation and the original product is disabled from operation.

Forth discloses a replacement product, wherein when the verification and activation module (RFD tags) is removed from the original product and coupled to the replacement product, the replacement product is enabled for operation and the original product is disabled from operation (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s)

taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 39, Appalucci does not expressly disclose wherein once the replacement product has been enabled for operation by the verification and activation module, the original product cannot be enabled again by the verification and activation module.

Forth discloses wherein once the replacement product has been enabled for operation by the verification and activation module, the original product cannot be enabled again by the verification and activation module (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 40, Appalucci discloses an original product having a first verification and activation module (Paragraph 0004).

Appalucci does not expressly disclose a replacement product having a second verification and activation module, wherein when the first verification and activation module is in communication with the second verification and activation module, the replacement product is enabled for operation and the original product is disabled from operation.

Forth discloses a replacement product having a second verification and activation module, wherein when the first verification and activation module is in communication with the second verification and activation module, the replacement product is enabled for operation and the original product is disabled from operation (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 47, Appalucci does not expressly disclose the step of programming data about a manufacturer of the product into the activation module.

Forth discloses the step of programming data about a manufacturer of the product into the activation module (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 48, Appalucci discloses providing an original product having a verification and activation module (Paragraph 0004); providing a replacement product (Paragraph 0004).

Appalucci does not expressly disclose removing the verification and activation module from the original product; and installing the verification and activation module in the replacement product, wherein the replacement product is enabled for operation and the original product is disabled from operation.

Forth discloses removing the verification and activation module from the original product (Paragraphs 0005, 0020, 0048); and installing the verification and activation module in the replacement product, wherein the replacement product is enabled for operation and the original product is disabled from operation (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 49, Appalucci does not expressly disclose providing an original product having a first verification and activation module; providing a replacement product having a second verification and activation module; and communicating between the first and second verification and activation modules such that the replacement product is enabled for operation and the original product is disabled from operation.

Forth discloses providing an original product having a first verification and activation module (Paragraphs 0005, 0020, 0048); providing a replacement product having a

second verification and activation module (Paragraphs 0005, 0020, 0048); and communicating between the first and second verification and activation modules such that the replacement product is enabled for operation and the original product is disabled from operation (Paragraphs 0005, 0020, 0048).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Appalucci to include the step(s) taught by Forth as discussed above in order to for the activation computer is configured to receive destination information for the package along with the activation code.

Referring to claim 51, Appalucci discloses providing a product having a verification and activation module, wherein the verification and activation module has a non-volatile memory (Paragraph 0004); and writing into the non-volatile memory service information (Paragraph 0004).

***Examiner's Note:***

7. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (9:00am -7:00pm), Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

Art Unit: 3621

Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

Shahid Kamal  
May 21, 2008

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621